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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,043	06/15/2001	Guenter Jokschas	178/50052	5173

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EXAMINER	
OCAMPO, MARIANNE S	
ART UNIT	**PAPER NUMBER**
1723	9

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/881,043	JOKSCHAS ET AL.	
	Examiner	Art Unit	
	Marianne S. Ocampo	1723	

-- The MAILING DATE of this communication appears on the cov r sh t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Previously Indication of Allowable Subject Matter

1. The indicated allowability of claims 6 – 7, as stated in the last office action, which resulted in the current version of the base claim 1 (presented in Paper no. 8, Amendment A filed by the applicants on 12-20-02) has been withdrawn in view of the newly discovered references to Smith et al. (US 6,358,422 B1), Janke et al. (US 5,234,601), Van Eweyk (US 2,049,530) and Okada et al. (EP 754,483). In light of these new references, previously made agreements with regards to cancellation of claims 10 – 12, have been withdrawn. All claims are still pending. Rejections based on the newly cited references follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 10 is rejected under 35 U.S.C. 102(e) and (a) as being anticipated by Smith et al. (US 6,358,422).

4. With regards to claim 10, Smith et al. disclose a filter cartridge (104) comprising an annularly constructed filter medium arranged between two axial end plates (134 & 136) wherein the filter medium is provided with a lateral recess (through which the probe body 162 of a probe 160 is being arranged) for accommodating a functional part (162, 160) of a filter (44) in which the filter cartridge is to be installed, as in figs. 2 – 3, 11 & 14 and cols. 8 – 14.

5. Claims 10 and 12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Glebovsky et al. (US 5,520,800).

6. With regards to claim 10, Glebovsky et al. disclose a filter cartridge comprising an annularly constructed filter medium (7) arranged between two axial end plates wherein the filter medium is provided with a lateral recess (through which the rods 8 are being arranged) for accommodating a functional part (8) of a filter (1) in which the filter cartridge is to be installed, as in figs. 1 - 2 & cols.1 – 4.

7. Concerning claim 12, Glebovsky et al. also disclose the filter medium (7) being a pleated filter medium and the lateral recess comprising a pocket formed by an enlarged spacing between two adjacent pleats, as in fig. 2.

8. Claims 10 - 11 are rejected under 35 U.S.C. 102 (b) as being anticipated by Van Eweyk (US 2,049,530).

9. With regards to claim 10, Van Eweyk discloses a filter cartridge comprising an annularly constructed filter medium (24) arranged between two axial end plates (formed by an upper and a lower screens 23 & 25, respectively) wherein the filter medium (24) is provided with a lateral recess (through which a suction discharge tube (28) is being arranged) for accommodating a functional part (28) of a filter (15) in which the filter cartridge is to be installed, as in figs. 1 & 3 - 4 & pages 1 - 2.

10. Concerning claim 11, Van Eweyk also discloses the two axial end plates (23, 25) being provided with notches aligned with the lateral recess in the filter medium (24) so that the functional part (28) can be inserted in an axial direction through one of the end plates into the lateral recess of the filter medium, as in fig. 1.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1 and 5 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (422) in view of Janke et al. (US 5,234,601).

13. Regarding claims 1 and 6 - 7, Smith et al. disclose a filter comprising a filter housing (44) having an inlet (42) and an outlet (46) for a fluid to be filtered, a filter cartridge (55, 104) arranged in the housing (44) so that the fluid from said inlet must flow through the filter cartridge (55,104) to reach the outlet (46) and an additional functional part (60, 162), said filter cartridge (104, in particular) comprising an annularly constructed filter medium arranged

between two axial end plates (134, 136) and wherein said filter medium of said filter cartridge (104) is provided with a lateral recess (through which the probe 162 would be inserted through and arranged therein) for accommodating said additional functional part (162) of said filter and said additional functional part comprising a probe (162) for measuring or monitoring adsorption capacity of the filter medium, as in figs. 2 – 3, 6, 11 and 14 and cols. 8 - 14. Although Smith et al. do not teach the probe (162) of the filter (44) being a probe of a water level sensor, it is considered obvious to one of ordinary skill in the art to modify the additional functional part (i.e. probe) of Smith et al. by substituting it for a probe of a water level sensor, as a matter of choice of the user in order to provide an alternative additional functional part which enables the user to monitor and measure other conditions within the filter, such as the water level within the filter cartridge. Janke et al. teach a similar filtering device or apparatus to that of Smith et al. comprising a filter housing (12) having an inlet and an outlet for a fluid to be filtered therein and a filter medium (14) arranged within the housing (12) through which the fluid must flow from the inlet to the outlet and an additional functional part comprising a suction tube of a liquid discharge tube (16) and the filter medium (14) having a lateral recess for accommodating the additional functional part or the suction tube (16), as in fig. 1 and in cols. 3 – 5. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filter of Smith et al., by adding the embodiment taught by Janke et al., in order to provide an alternative design for fluid flow through the filter housing, as well as provide an alternative path for the filtered fluid out of the housing.

14. Concerning claim 5, Smith et al. also disclose the lateral recess in the filter medium of the filter cartridge (104) extending axially at least one of the end plates (136) of the filter cartridge (104) and said one of the end plates (136) being provided with a notch/recess which registers with the lateral recess in the filter medium, as in fig. 14.

15. With regards to claim 8, Smith et al. further disclose the housing (44, 124) comprising a housing cup and a housing cover and wherein a portion (72, 74, 80, 81) of the functional part (160, 162, 60) is mounted on the cover (top end) of the housing (44, 124) and extending into the lateral recess in the filter medium of the cartridge when the cartridge (104) is installed in the using (124, 44), as in figs. 3 - 4, 6 and 14.

16. Claims 1 – 4 and 9 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glebovsky et al. (US 5,500,800) in view of Okada et al. (EP 754,483).

17. Concerning claims 1 and 6 - 7, in this particular rejection, the examiner has considered that the additional functional part has not been positively recited as one of the limitations of the filter, but merely that the filter medium's lateral recess is provided to accommodate the additional functional part. Glebovsky et al. disclose a filter comprising a filter housing (1, 2) with an inlet (3) and an outlet (4) for a fluid to be filtered, a filter cartridge (10, 7) arranged in the housing so that fluid from the inlet must flow through the filter cartridge to reach the outlet and an additional functional part (here, the additional functional part is part of where

the fluid is made to flow and considered to be any functional parts which has some function other than filtering, for example the alkaline reagent and iodine rods 8 which provides for stabilization of oil properties thereby providing a special tribochemical reaction), and the filter cartridge comprising an annularly constructed filter medium (7) arranged between two axial end plates and the filter medium provided with at least one lateral recess for accommodating the additional functional part (8), as in figs. 1 - 2. Although Glebovsky et al. do not disclose the additional functional part being a probe of a water level sensor or a suction tube of a liquid discharge, it is considered by the examiner that since the additional functional part is not positively recited that the structural features of the claim have already been met and that it is irrelevant what type of additional functional parts is placed or provided/arranged in the lateral recess of the filter medium and simply would be a matter of choice by the user to place whatever additional functional parts (i.e. water level probe, additional water discharge suction tubes or additional filtering or separating elements such as those disclosed by Glebovsky et al.) [claims 6 – 7].

18. On the other hand, in the event that the additional functional part is indeed, positively recited (i.e. included as one of the features of the filter), Okada et al. teach a similar filtering device as that of Glebovsky et al., comprising a housing with an inlet and an outlet for a fluid to be filtered and a filter cartridge (124) disposed therein so that fluid from the inlet must flow through the filter cartridge to reach the outlet, and an additional functional part (a probe of a fuel level sensor, 140) and the filter cartridge comprising an annularly constructed filter medium (124

in the embodiment in fig. 13) provided with a lateral recess (between pleats) to accommodate the probe (140) therein, as in figs. 1 - 2 and 13 and cols. 5 – 9. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filter element/medium of Glebovsky et al., by adding the embodiments taught by Okada et al., in order to provide an alternative design for the fuel filter as well as provide a probe means for measuring levels of fluid (may it be fuel or water) within the filter housing to indicate to the user the extent of the filtration at any given point in time.

19. Regarding claim 2, Glebovsky et al. disclose the filter medium comprising a folded sheet of filter material (7) with lateral edges joined to form a tubular structure, as in fig. 2.

20. With respect to claim 3, Glebovsky et al. also disclose the sheet of filter medium/material (7) being folded in a zig-zag fashion to form a pleated structure, as in fig. 2.

21. Concerning claim 4, Glebovsky et al. further disclose the lateral recess being a pocket formed by an enlarged distance between adjacent folds, as in fig. 2.

22. With regards to claim 8, Glebovsky et al. as modified by Okada et al. also teach the housing comprising a housing cover (top end, 104) and housing cup (body, 126) and the functional part (140) being provided on the cover/top end (104, 122) of the housing and extending into the lateral recess (formed by the space between pleats in the filter element shown

in fig. 13) of the filter medium (in fig. 13) when the cartridge is installed in the housing (122), as in figs. 1 – 2 and 13.

23. Regarding claim 9, Glebovsky et al. further disclose the filter being a fuel filter for an internal combustion engine, as in cols. 1 – 4.

Response to Arguments and Amendments

24. Applicant's arguments with respect to claims 1 – 12 have been considered but are moot in view of the new grounds of rejection presented above.

25. **This action is non-final.**

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

28. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.S.O.
March 10, 2003

W. L. WALKER
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